

REMARKS

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119(a)-(d), and for confirming that the certified copy of the priority document has been received at the Patent Office.

Drawings:

Applicant thanks the Examiner for indicating that the proposed drawing corrections filed on July 24, 2003 have been approved. Applicant submits herewith Replacement Sheets of Figures 1, 2 and 4 which incorporate the approved proposed changes.

Claim Rejections:

Claims 1, 3-8 and 15 are all of the claims pending in the present application, and currently all of the claims stand rejected.

35 U.S.C. § 103(a) Rejection - Claims 1, 3-8 and 15:

Claims 1, 3-8 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,823,255 to La Gase et al. in view of U.S. Patent No. 4,284,842 to Arroyo. In view of the following discussion, Applicant respectfully disagrees.

As an initial matter, Applicant notes that the limitations of claim 6 have been incorporated into claim 1. Further, Applicant notes that the Examiner asserts that this feature of the claimed invention is "inherent" in the teachings of Arroyo. Applicant respectfully disagrees.

When attempting to establish the invalidity of a claim, it must be shown that "all of the elements and limitations of the claim are found within a single prior art reference." Scripps Clinic & Research Foundation, Revlon, Inc. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir.

1991) (citations omitted). “There must be no difference between the claimed invention and the reference disclosure,” the subject matter in the reference “must be identical in all material respects.” See Id.; and Hupp v. Siroflex of America Inc., 43 U.S.P.Q.2d 1887, 1890 (Fed. Cir. 1997). As stated above, this is not the case with regard to the pending claims as both La Gase and Arroyo fail to disclose this feature of the invention. *See supra*.

Applicant does acknowledge that when a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention. See In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981). However, evidence of inherency in a reference “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. (citing In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also Scaltech Inc. v. Retec/Tetra L.L.C., 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure. See Finnigan Corp. v. I.T.C., 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference

that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference). In the present case, having an offset of 180 degrees is not inherently present in either of the above prior art references. This is recognized by the Examiner, who states that “Arroyo teaches that the first strip (51) and the second strip (52) of the tape layer (51 & 52) *may* be longitudinally wrapped...” Office Action dated August 18, 2003, page 4 (emphasis added). Therefore, this feature of the present invention is not “inherently” taught by either of the above cited references.

In view of the foregoing, Applicant submits that the present invention, as set forth in claim 1, is neither disclosed, taught or suggested in the above cited references, either expressly or inherently. Therefore, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of claim 1. Further, as claims 3-8 and 15 incorporate the limitations of claim 1, Applicant submits that these claims are also allowable, at least by reason of their dependence.

With regard to claim 16, Applicant notes that neither of the above references disclose having two longitudinally introduced tapes in direct contact with each other. Namely, the layer 13 is disposed between the layers 12 and 14.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No.: 09/981,713

Our Ref.: Q64444
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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Terrance J. Wikberg
Registration No. 47,177

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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